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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HARRELL, ROBERT B

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,981	Applicant(s) NIELSON ET AL.	
	Examiner Robert B. Harrell	Art Unit 2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005 et seq.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-114 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-114 are present for consideration.
2. Since a patent may only be granted on an invention (each in the singular), restriction to one of the following inventions is required under 35 U.S.C. 121 (see 37 CFR 1.141):

Group I. Claims 1-14, 58-77, 110-114, drawn to a mobile telephone terminal arranged to provide a user with a selectable option during a telephone call with a first party, the selection of which initiates communication with the first party by instant messaging. Classified in Class 709, subclass 204.

Group II. Claims 15-28, drawn to a mobile telephone terminal arranged to provide a user with a selectable option while instant messaging with a first party, the selection of which initiates a telephone call with the first party. Classified in Class 379, subclass 201.01.

Group III. Claims 29-57 and 78-96, drawn to a mobile telephone terminal comprising at least one mobile telephone application, wherein the mobile telephone application is arranged to display to a user a presence attribute indicator for a first party with an entry associated with the telephone number of the first party. Classified in Class 701, subclass 200.

Group IV. Claims 97-109, drawn to a terminal comprising an instant messaging client for participating in an instant messaging dialogue with one or more parties; and a calendar application, for recording appointments, arranged to store the content of an instant messaging dialogue in an appointment record. Classified in Class 455, subclass 565.

3. Inventions I and II are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group I has separate utility such as in a mobile telephone terminal arranged to provide a user with a selectable option during a telephone call with a first party, the selection of which initiates communication with the first party by instant messaging not used in a mobile telephone terminal arranged to provide a user with a selectable option while instant messaging with a first party, the selection of which initiates a telephone call with the first party as claimed in Group II.

4. Inventions I and III are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group I has separate utility such as in a mobile telephone terminal arranged to provide a user with a selectable option during a telephone call with a first party, the selection of which initiates communication with the first party by instant messaging not used in a mobile telephone terminal comprising at least one mobile telephone application, wherein the mobile telephone application is arranged to display to a user a presence attribute indicator for a first party with an entry associated with the telephone number as claimed in Group III.

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5. Inventions I and IV are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group I has separate utility such as in a mobile telephone terminal arranged to provide a user with a selectable option during a telephone call with a first party, the selection of which initiates communication with the first party by instant messaging not used in a terminal comprising an instant messaging client for participating in an instant messaging dialogue with one or more parties; and a calendar application, for recording appointments, arranged to store the content of an instant messaging dialogue in an app as claimed in Group IV.

6. Inventions II and I are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group II has separate utility such as in a mobile telephone terminal arranged to provide a user with a selectable option while instant messaging with a first party, the selection of which initiates a telephone call with the first party not used in a mobile telephone terminal arranged to provide a user with a selectable option during a telephone call with a first party, the selection of which initiates communication with the first party by instant messaging as claimed in Group I.

7. Inventions II and III are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group II has separate utility such as in a mobile telephone terminal arranged to provide a user with a selectable option while instant messaging with a first party, the selection of which initiates a telephone call with the first party not used in a mobile telephone terminal comprising at least one mobile telephone application, wherein the mobile telephone application is arranged to display to a user a presence attribute indicator for a first party with an entry associated with the telephone number as claimed in Group III.

8. Inventions II and IV are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group II has separate utility such as in a mobile telephone terminal arranged to provide a user with a selectable option while instant messaging with a first party, the selection of which initiates a telephone call with the first party not used in a terminal comprising an instant messaging client for participating in an instant messaging dialogue with one or more parties; and a calendar application, for recording appointments, arranged to store the content of an instant messaging dialogue in an app as claimed in Group IV.

9. Inventions III and I are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group III has separate utility such as in a mobile telephone terminal comprising at least one mobile telephone application, wherein the mobile telephone application is arranged to display to a user a presence attribute indicator for a

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first party with an entry associated with the telephone number not used in a mobile telephone terminal arranged to provide a user with a selectable option during a telephone call with a first party, the selection of which initiates communication with the first party by instant messaging as claimed in Group I.

10. Inventions III and II are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group III has separate utility such as in a mobile telephone terminal comprising at least one mobile telephone application, wherein the mobile telephone application is arranged to display to a user a presence attribute indicator for a first party with an entry associated with the telephone number not used in a mobile telephone terminal arranged to provide a user with a selectable option while instant messaging with a first party, the selection of which initiates a telephone call with the first party as claimed in Group II.

11. Inventions III and IV are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group III has separate utility such as in a mobile telephone terminal comprising at least one mobile telephone application, wherein the mobile telephone application is arranged to display to a user a presence attribute indicator for a first party with an entry associated with the telephone number not used in a terminal comprising an instant messaging client for participating in an instant messaging dialogue with one or more parties; and a calendar application, for recording appointments, arranged to store the content of an instant messaging dialogue in an app as claimed in Group IV.

12. Inventions IV and I are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group IV has separate utility such as in a terminal comprising an instant messaging client for participating in an instant messaging dialogue with one or more parties; and a calendar application, for recording appointments, arranged to store the content of an instant messaging dialogue in an app not used in a mobile telephone terminal arranged to provide a user with a selectable option during a telephone call with a first party, the selection of which initiates communication with the first party by instant messaging as claimed in Group I.

13. Inventions IV and II are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group IV has separate utility such as in a terminal comprising an instant messaging client for participating in an instant messaging dialogue with one or more parties; and a calendar application, for recording appointments, arranged to store the content of an instant messaging dialogue in an app not used in a mobile telephone terminal arranged to provide a user with a selectable option while instant messaging with a first party, the selection of which initiates a telephone call with the first party as claimed in Group II.

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14. Inventions IV and III are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention of Group IV has separate utility such as in a terminal comprising an instant messaging client for participating in an instant messaging dialogue with one or more parties; and a calendar application, for recording appointments, arranged to store the content of an instant messaging dialogue in an app not used in a mobile telephone terminal comprising at least one mobile telephone application, wherein the mobile telephone application is arranged to display to a user a presence attribute indicator for a first party with an entry associated with the telephone number as claimed in Group III.

15. An undue burden would be placed upon examiner since the search each Group would be in classes and subclasses not required for the other Groups.

16. Because these inventions are independently distinct from each other for the reasons given above and because they have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter and the search for each Group is not required for the other Group, restriction for examination purposes as indicated is proper.

17. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

18. The applicant is also advised that the response must be submitted to the Office ***within ONE [1] Month*** or 30 days, whichever is longest.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006. The fax phone number for all papers is (571) 273-8300.

21. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Robert B. Harrell/
ROBERT B. HARRELL
PRIMARY EXAMINER
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